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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,235	03/19/2001	Franklin Goodhue Woodward	WVANP012	3417

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IPVENTURE, INC.
5150 EL CAMINO REAL
SUITE A-22
LOS ALTOS, CA 94022

EXAMINER

JASMIN, LYNDIA C

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,235

Applicant(s)

WOODWARD ET AL.

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-36 and 61-90 is/are pending in the application.
- 4a) Of the above claim(s) 78-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-36,61-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Amendment received December 08, 2004 has been acknowledged. Claims 3, and 37-60 have been cancelled, and new claims 78-90 have been added.
2. Newly submitted claims 78-90 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 78-90 are directed as subcombinations disclosed as usable together in a single combination. In the instant case, claims 78-90 have separate utility such as denying or permitting requested delivery time based on regulated product. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 78-90 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 5, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breen, Jr. et al. (6,598,027 B1), in view of Tracy (5,979,757).

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Breen, Jr. et al. al discloses a system and method for implementing e-commerce transactions via a network (20) comprising: identifying a regulated item that satisfies one or more predetermined criteria, indicating that the item is prohibited from being purchased by the customer (see col. 1, lines 15-57), the one or more predetermined criteria corresponding to at least one regulation which restricts sales of the regulated item to persons in a particular jurisdiction (see Fig. 7; col. 10, lines 25-27), and taking action to prevent the purchase of the regulated item (see block 245) via the data network by the customer in accordance with the at least one regulation (see Figures 1 and 3). The action comprises steps to prevent completion of checkout (see col. 10, lines 16-36). Breen, Jr. et al further disclose an inventory subsystem (16b), a customer interface (12), and an order fulfillment subsystem (23).

However, Breen et al. fails to explicitly disclose the at least one regulation restricts sales of the related item during at least one specific day.

Tracy discloses a checkout system that automatically prohibits the sale of items during specific days (see col. 13, line 57 through col. 14, line 2).

Thus, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the purchase of regulated items of Breen, Jr. to include the informing that selected item is a restricted item and cannot be purchased by the customer at that time as taught by Tracy et al. in order to ensure that the system complies with existing laws.

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5. Claims 16, 17, 20, 22-24, 27, 29-31, 35, 61-63, 67 and 69-72, and 73-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breen, Jr. et al. (6,598,027 B1), in view of Tomsen (2002/0013950 A1).

Breen, Jr. et al. al discloses a system and method for implementing e-commerce transactions via a network (20) comprising: identifying a regulated item that satisfies a predetermined criteria, wherein the predetermined criteria indicates that the item is prohibited from being purchased by the customer (see col. 1, lines 15-57); and taking action to prevent the purchase of the regulated item (245). The action is automatically implemented by a system server (see Figures 1 and 3). The predetermined criteria include a regulation parameter that corresponds to regulations that restrict sales and deliveries to a particular jurisdiction (see Fig. 7). The action comprises steps to prevent completion of checkout (see col. 10, lines 16-36). Breen, Jr. et al. further disclose an inventory subsystem (16b), a customer interface (12), and an order fulfillment subsystem (23). However, Breen et al. fails to explicitly disclose modifying a display of items available for purchase by the customer by restricting display of items, which are prohibited from being purchased by the customer.

Tomsen discloses the concept of conducted transaction using an interactive television system. Tomsen further discloses a family safe viewing system to review item/information that are saved in a shopping cart. The family safe can display a listing of items such as listing of pending transactions. The family safe also stores information such as restrictions on purchases by individual family members such as children. From this teaching of Tomsen, it would have been obvious to one of ordinary skill in the art at

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the time the invention was made to modify the e-commerce transaction of Breen, Jr. et al. to include the viewing and storing of information including restricted purchase items of taught by Tomsen in order to prevent children from viewing and purchasing restricted goods and services.

As per preventing the customer from adding/removing an item to/from a cart, Breen, Jr. et al. teaches a registration process for potential buyers (see Fig. 10A-F) and a login screen for allowing users to enter a "Secured For Trade" portion of the web site (Fig. 11). Thus, It would have been obvious to one of ordinary skill in the art at the time the invention was made to only display items for which a person is authorized to purchase for security purposes. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prevent a customer from adding a restricted item to his cart, or removing such an item from his cart to facilitate checkout.

6. Claims 1-6, 8, 10-20, 22-27, 29-34, 36, 61-66 and 68-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo et al. (2001/0042021 A1), in view of Tomsen (2002/0013950 A1), and further in view of Tracy (5,979,757).

Matsuo et al disclose a system and method for implementing e-commerce via a network (10) comprising identifying a regulated item selected by a customer, wherein the item satisfies a predetermined criteria indicating that the item is prohibited from being purchased by the customer in a particular jurisdiction (paragraph 110); and automatically taking action to prevent the customer from completing a checkout operation for the regulated item (see paragraphs 111-112). The product is an alcohol

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product, and the predetermined criteria correspond to regulations that restrict the sales to persons under a minimum age. However, Matsuo et al. fails to explicitly disclose modifying a display of items available for purchase by the customer by restricting display of items, which are prohibited from being purchased by the customer. Tomsen discloses the concept of conducted transaction using an interactive television system. Tomsen further discloses a family safe viewing system to review item/information that are saved in a shopping cart. The family safe can display a listing of items such as listing of pending transactions. The family safe also stores information such as restrictions on purchases by individual family members such as children. From this teaching of Tomsen, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the e-commerce transaction of Breen, Jr. et al. to include the viewing and storing of information including restricted purchase items of taught by Tomsen in order to prevent children from viewing and purchasing restricted goods and services. As per preventing the customer from adding the item to a cart, or removing the item from a cart. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement any of these steps to facilitate checkout.

The Matsuo et al. and Tomsen combination discloses all of the limitations of the claims except for regulations restricting sales during specific days. Tracy et al disclose a checkout system that automatically prohibits the sale of items during specific days (see col. 13, line 57 through col. 14, line 2). Thus, It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings

of Tracy et al. with the invention of the Matsuo et al and Tomsen combination to ensure that the system complies with existing laws.

Response to Arguments

7. Applicant's arguments filed December 8, 2004 have been fully considered but they are not persuasive.

Applicants are reminded that during examination, claims are given their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).¹ Furthermore, "[a]bsent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation." *Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029.

Thus, under the broadest reasonable interpretation standard noted above, the Examiner maintains her interpretations. However, to the extent that the Examiner's definitions are either different from or in dispute with Applicant's definitions (and unless the Examiner expressly noted otherwise), the Examiner hereby adopts the following definitions as the broadest reasonable interpretation and ordinary and accustoms meaning in all her claim interpretations:

The Examiner points in particular to Merriam-Webster's Collegiate Dictionary as support for their interpretations:

Prohibit “1. To forbid by authority: *Smoking is prohibited in most theaters.* 2.

To prevent from doing something; preclude.” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

Applicants first argue “Tracy fails to teach or suggest that the purchase or delivery of the restricted item is in any way prevented in a computer-implemented manner during specific days. The Examiner respectfully disagrees. Tracy discloses the concept of a central host programmed to inform customers that a selected item is a restricted item and cannot be purchased by the consumer at that time, and gives example of alcohol beverages that may not be sold on Sundays in some states.

Second, in response to applicant's argument that Tomsen is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Examiner notes that Tomsen is used for the teaching of using a set top box to initiate transaction where viewers can resumed transaction saved in a shopping cart.

Applicants further argue “there is no teaching or suggestion in Tomsen for restricting display of items which are prohibited from being purchased by a customer based upon one or more predetermined criteria. The Examiner respectfully disagrees.

¹ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

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Tomsen discloses displaying a listing of item such as pending transaction, and store information on restricted purchases by individual family members.

Applicants' arguments having been found unpersuasive, the rejection has not been withdrawn.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lynda Jasmin
Primary Examiner
Art Unit 3627
8/21/05

lj